

REMARKS

The claims remaining in the present application are Claims 1-2, 4-13, and 15-17. Claims 1-2, 4-5, 9, 13, and 15-16 have been amended. Claims 3 and 14 have been cancelled, without prejudice. No new matter has been added as a result of these amendments.

ALLOWABLE SUBJECT MATTER

The Examiner has indicated that Claims 3-7 and 11-17 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, ¶2 and to include all limitations of the base claim and any intervening claims.

Claim 9 has been amended to incorporate all limitations from Claim 14. Applicants respectfully assert that amendments to Claim 9 discussed in the response to the 35 U.S.C. §112 rejection overcome that rejection. Therefore, Claim 9 is respectfully believed to be allowable.

Amendments to Claim 16 are respectfully believed to overcome the 35 U.S.C. §112, ¶2 rejection. Therefore, Claim 16 is respectfully believed to be allowable.

Claims 11-13, 15, and 17 are respectfully believed to be allowable by virtue of dependency on Claims 9 and 16.

PRIORITY

The Application claims priority to U.S. Provisional Application No. 60/243,708 filed October 26, 2000. The rejection has denied the priority claim asserting that the provisional application does not appear to enable the claimed invention under 35 U.S.C. §112, ¶1. The Applicant respectfully traverses the refusal to grant a priority date on the grounds that the rejection fails to present a *prima facie* case.

RELIANCE ON PRIORITY UNDER 35 U.S.C. 119(e)

Under 35 U.S.C. 119 (e), the claims in a U.S. Patent Application are entitled to the benefit of the filing date of a provisional application if the corresponding provisional application supports the claims in the manner required by 35 U.S.C. 112, first paragraph (emphasis added). *In re Ziegler*, 992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir. 1993); *Kawai v. Metlesics*, 480 F.2d 880, 178 USPQ 158 (CCPA 1973); *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989).

The rejection does not provide any analysis or reasons as to why any specific claim in the case is not supported in the manner required by 35 U.S.C. 112, first paragraph. Therefore, the rejection fails to meet its burden of establishing a *prima facie* case. As such, Applicant respectfully requests that the benefit of the filing date of a provisional application be accorded to all claims in the present application.

CLAIM REJECTIONS

35 U.S.C. §112

Claims 1-17 are rejected under 35 U.S.C. §112, ¶2, as being incomplete for omitting essential elements. Applicant has amended Independent Claim 1 reciting that, “said DUT comprises a data line and a clock line”. Claims 9 and 16 have been amended to recite similar limitations. Applicant respectfully asserts that the amended claims comply with 35 U.S.C. §112, ¶2.

35 U.S.C. §102

Claims 1-2 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Beck et al. U.S. Patent No. 5,493,723 (hereinafter Beck). The rejection is respectfully traversed for the following reasons.

Claim 1 recites, in part:

the DUT conveying I/O read information to the emulator device  
over said data line during a data transfer phase.

The Examiner has indicated allowability of original Claim 3, which depended from Claims 1 and 2. Claim 1 has been amended to incorporate limitations from Claim 3. Limitations from Claim 2 have not been incorporated into Claim 1. However, Applicants respectfully assert that amended Claim 1 is neither taught nor suggested by Beck.

For the foregoing reasons, Claim 1 is respectfully believed to be allowable over Beck.

Independent Claim 9 is respectfully believed to be allowable in light of the amendments discussed herein.

Claims 2, 8, and 10 are respectfully believed to be allowable based on dependency from Claims 1 and 9.

CONCLUSION

In light of the above-listed remarks, Applicant respectfully requests allowance of the Claims 1-2, 4-13, and 15-17.

Should the Examiner have a question regarding the instant amendment and remarks, the Applicant invites the Examiner to contact the Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,  
WAGNER, MURABITO & HAO LLP

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Ronald M. Pomerenke  
Registration No. 43,009

Address: WAGNER, MURABITO & HAO LLP  
Two North Market Street  
Third Floor  
San Jose, California 95113

Telephone: (408) 938-9060 Voice  
(408) 938-9069 Facsimile